

REMARKS

The applicant again appreciates the examiner's review of the prior art and requests reconsideration of the pending claims in view of the following remarks.

The rejections in view of Purdy and Luther were maintained in the latest office action, dated October 5, 2005. Applicants maintain that the claims as defined are patentable in view of the cited art.

To reiterate, claim 1 defines a valve having, among other things, a fluid chamber that expands to a larger volume when open than when closed. The total fluid channel also has a larger volume when open (i.e., the "volumetric relationship" discussed below and in the prior amendment). The cited art does not teach such a device.

Page 9 of the office action nevertheless refutes this by stating that the "claimed invention must result in a structural difference between the claimed invention and the prior art in order to distinguish the claimed invention from the prior art." The applicants agree with this, but wish to point out that the office action may be ignoring the volumetric relationships between the various claimed elements.

Specifically, it is well settled that an applicant is free to recite features of an apparatus claim either structurally or functionally. In fact, the applicants did just that by describing the volumetric relationships. Applicants therefore encourage the examiner to consider all the words of the claim, including those describing the volumetric relationships, to limit the scope of the claim – those limitations cannot be ignored.

To anticipate the claim, the prior art therefore must show the volumetric relationship (among other things) either inherently or expressly. The office action and applicants appear to agree that there is no express discussion of the volumetric relationships. The office action and applicants disagree, however, about whether either Purdy or Luther inherently discloses the volumetric

relationship. As stated at MPEP 2112, IV, to establish inherency, the extrinsic evidence (i.e., the cited art) must make clear that the missing descriptive matter (i.e., the volumetric relationship) is necessarily present in the thing described in the reference. Of course, this clear showing must be recognized by one of ordinary skill in the art. Applicants thus wish to reiterate (both below and in the prior response) that the volumetric relationships are not present in the cited art¹.

With regard to Purdy, page 3 of the office action states that radial expansion of the Purdy chamber causes the overall fluid channel to have a larger volume when in the open mode. To support this conclusion, the office action states "(when the resilient member 42 is pushed down by plug 57 and radially expands, a flow path is opened, and the fluid channel will inherently have a larger volume in the open mode)."

This rationale, however, necessarily ignores a number of other factors, such as the response of the resilient member 42 as it is compressed. In particular, the resilient member should radially expand, thus taking up much of the volume that was within the housing before compression. Contrary to the requirement of the claim, this expansion may decrease the chamber volume and the total channel volume. The extrinsic evidence therefore does not make it clear that the volumetric relationship is necessarily present in the Purdy valve. Accordingly, Purdy should not be relied upon to reject the claims. Simply suggesting that the opening formed to open the valve produces the volumetric relationship impermissibly extends the disclosure of Purdy beyond its reasonable scope. Claim 1 therefore is patentable in view of Purdy. All of the other claims similarly are allowable over Purdy for the same reasons.

¹ As noted at various locations of the specification, the volumetric relationship produces a positive force that forces fluid through the distal port of the valve. For example, lines 1-16 of page 11 discuss how fluid flows through the fluid channel; in this case, beginning at the opened aperture 32, through fluid chamber 36, and then through the distal channel to the distal port 16. Neither Purdy nor Luther suggests a positive force that forces fluid through their respective distal ports in this manner. If they did have the volumetric relationship, then they should produce this positive force.

The office action makes similar incomplete inferences when discussing Luther. As a preliminary matter, in support of the rejection, the office action appears to point to the slit 34 of Luther as a chamber. One of ordinary skill in the art would not consider the slit 34 to be a chamber, especially when in the closed mode. Among other differences, a slit has a zero volume when closed, while a chamber has a non-zero volume. Moreover, the differences between a slit and chamber are brought out in the applicants' specification by differentiating the aperture 32 (i.e., a slit) and the chamber 36. The applicants selected the term "chamber" to not mean a slit, otherwise the aperture 32 would have been named a chamber.

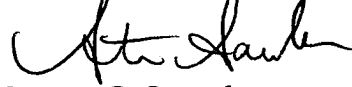
Even if the slit is incorrectly considered to be a chamber (for the sake of discussion), then it cannot be inferred that the fluid channel is larger when open. The office action suggests, however, that opening of the slit 34 inherently causes the fluid channel to have a larger volume. Again, in a manner similar to the discussion above regarding Purdy, this ignores at least one additional factor. Specifically, it ignores a number of other possible reactions of the septum 33 when opened, which simply may push additional material into other portions of the fluid path, thus taking up a volume of space that equals or exceeds that of the opening. For example, the material around the slit simply could be pushed distally and thus, take up the same amount (or more) of space as opened up by the slit 34. Luther is silent to this entire process and either scenario cannot be assumed. Accordingly, Luther does not make it clear (to one of ordinary skill) that the volumetric relationship is necessarily present in the Luther valve. Reading Luther in the claimed manner impermissibly enlarges its scope. Accordingly, claims 1-21 are allowable over Luther.

The application therefore is in condition for allowance and such action is

Appl. No. 10/687,515
Response dated December 30, 2005
Reply to office action of October 5, 2005

earnestly solicited. Applicants request that the examiner contact applicant's attorney, Steven Saunders, if it will assist examination of the pending claims.

Respectfully submitted,



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